

Application No.: 09/636,104

12

Docket No.: 471842000100

REMARKS

Claims 1-8, 11-18, 23, 24, 28, 32-34, 36-38, 40, 41, 44-47, 50-52, 68, 69, and 74-83 are pending in this application. Claim 77 is herein amended to correct a typographical error. The amendment corrects an obvious error, and thus adds no new matter.

The applicant appreciates the Examiner's communication indicating that all claims are allowable except for claims 74-80.

Claims 74-80 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement.

Claim 1 is directed to a method in which a moiety-binding partner complex is manipulated by an acoustic force. Claim 74 depends from claim 1, and is directed to a method in which the method of claim 1 further comprises manipulating the complex by another physical force. According to the Examiner, "New claims 74-80 list various *additional* physical forces for manipulating the moiety-binding partner complex. No support has been found in the original disclosure for manipulating the moiety-binding partner complex with an acoustic force and an additional physical force, such as a magnetic force or an optical radiation force."

The applicant respectfully traverses this rejection. The application discloses that the invention includes manipulating a moiety-binding partner complex with multiple types of forces. For example, at page 7, lines 26-31, the specification says (emphasis added):

Any binding partners that both bind to the moieties with desired affinity or specificity and are manipulatable with the desired physical force(s) can be used in the present methods. Unlike the moieties to be manipulated, which can or cannot be manipulated directly by the physical forces, the binding partners must be directly manipulatable with the desired physical force(s). *One type of binding partner can possess properties that make it manipulatable by various physical forces.*

This passage explicitly indicates that a single binding partner can be manipulatable by "various physical forces". Since a binding partner within the invention can be manipulated by

sd-288325

Application No.: 09/636,104

13

Docket No.: 471842000100

various physical forces, the corresponding moiety-binding partner complexes are also clearly expected to be manipulatable by multiple physical forces.

Claim 1 is directed to a method of manipulating a moiety-binding partner complex using an acoustic force. One of ordinary skill reading the above passage from the specification would understand that the moiety—binding partner complex of claim 1, which is manipulatable by an acoustic force, could also be manipulated by at least one other force described in the application. Therefore, one would recognize that the applicant was in possession of the subject matter of claim 74, which involves manipulation by an acoustic force and an additional physical force disclosed in the specification, at the time the application was filed.

Claim 74 is directed to a method for manipulating a moiety-binding partner complex according to claim 1 where the method further employs manipulation by a second physical force. It is implicitly supported by the disclosure that a binding partner can be manipulatable by more than one type of force. (*See* MPEP 2163, “newly added claim limitations must be supported in the specification through express, implicit or inherent disclosure.”) The additional physical forces recited in claim 74 are selected from the suitable forces that are disclosed in the specification; for example at page 8, line 29 to page 9, line 7, each of the forces in claim 74 is disclosed as suitable for use in the methods of the invention.

Thus the specification as originally filed supports claim 74. It also supports claims 75-80, which are directed to methods using the individual additional physical forces recited in claim 74 in combination with an acoustic force. Accordingly, the rejection of claims 74-80 can be withdrawn.

sd-288325

Application No.: 09/636,104

14

Docket No.: 471842000100

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 471842000100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: January 13, 2006

Respectfully submitted,

By 
Michael G. Smith

Registration No.: 44,422
MORRISON & FOERSTER LLP
12531 High Bluff Drive
Suite 100
San Diego, California 92130-2040
(858) 720-5113

sd-288325